



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,924	07/21/2005	Christian Wierz	90500-000059/US	9538
30593 7590 12/16/2008 HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 8910 RESTON, VA 20195				
EXAMINER HOFFMAN, BRANDON S				
ART UNIT		PAPER NUMBER		
2436				
MAIL DATE		DELIVERY MODE		
12/16/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/542,924

Applicant(s)

WIRZ ET AL.

Examiner

BRANDON S. HOFFMAN

Art Unit

2436

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-8 are pending in this office action.
2. Applicant's arguments, filed September 2, 2008, have been fully considered but they are not persuasive.

Claim Rejections

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

4. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Handelman et al. (U.S. Patent No. 5,774,546).

Regarding claim 1, Handelman et al. teaches a method of **storing** and **transmitting** information generated by a first security module connected to a user unit, **the** first security module **includes** a unique identifier and specific information representative of its functioning, **the** first **security** module being able to be replaced by a second security module, **the** method comprising:

- **Determining** the specific information contained in the first security module intended for transmission (col. 5, lines 7-20 and fig. 5, ref. num 108),

Art Unit: 2436

- **Transferring the specific** information into the user unit (col. 5, lines 21-33),
- **Storing the specific** information in the user unit (col. 5, lines 46-55),
- **Replacing** the first security module by the second security module (col. 3, lines 49-60),
- **Connecting** of the user unit on a transmission network (fig. 1, ref. num 16 and 18),
- **Initializing** a transfer of information between the second security module and a management center (col. 3, line 61 through col. 4, line 9), **and**
- **Inserting** the user unit, of a data block in the blocks transmitted by the second **security** module, **the** data block **includes** the identifier of the first **security** module and the data specific to **the** first **security** module (col. 3, line 66 through col. 4, line 8).

Regarding claim 2, Handelman et al. teaches wherein the transfer of the specific information of the first security module is carried out at regular interval (col. 3, lines 52-55).

Regarding claim 3, Handelman et al. teaches wherein the transfer of the specific information of the first security module is carried out each time **the** information is modified (col. 3, lines 61-62).

Regarding claims 4, 7, and 8, Handelman et al. teaches wherein the transfer of the specific information is stopped after the replacement of the first **security** module by the second security module (col. 5, lines 33-45).

Regarding claim 5, Handelman et al. teaches wherein the transfer of the **specific** information is authorized as soon as a successful connection with the management center has been carried out (col. 3, line 66 through col. 4, line 8).

Regarding claim 6, Handelman et al. teaches wherein the transfer of the **specific** information is authorized by a command sent by the management center (col. 3, line 66 through col. 4, line 8).

Response to Arguments

5. Applicant argues:
 - a. Handelman et al. does not teach transferring the specific information into the user unit (page 9).
 - b. Handelman et al. does not teach inserting the user unit, of a data block in the blocks transmitted by the second security module, the data block including the identifier of the first security module and the data specific to the first security module (page 10).

Regarding argument (a), examiner disagrees with applicant. Data is transferred from one card to the next, as admitted by applicant (last paragraph of page 9). Figure 3 of Handelman et al., shows a card reader/writer unit. The unit includes a processor (62) and a memory (64). The data that is transferred from one card to the next MUST go through the card reader/writer unit, which uses the processor and memory. This is further explained in Handelman et al. at column 4, lines 32-45. Therefore, the specific information is transferred into the user unit when transferring of data takes place between the two smart cards.

Regarding argument (b), examiner disagrees with applicant. Column 3, line 66 through column 4, line 10 of Handelman et al., teaches that a parent card is inserted into one slot while a new main card is inserted into the other slot. The parent card provides authentication, verification, and validation of the new main card. Authentication, verification, and validation requires identification of the subject, in this case the new main card, and data specific to the first main security module, which would be the billing information.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANDON S. HOFFMAN whose telephone number is (571)272-3863. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser G. Moazzami can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 2436

/Brandon S Hoffman/

Primary Examiner, Art Unit 2436